

IN THE UNITED STATES PATENT AND TRADEMARK OFFICEApplicants: Nora Femenia *et al.*

Examiner: Pierre Elisca

Serial No.: 09/711,578

Group Art Unit: 3718

Filed: November 13, 2000

Docket No.: 2043.003US1

Customer No.: 49845

Confirmation No.: 7170

Title: AUTOMATED CROSS-CULTURAL CONFLICT MANAGEMENT

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

The undersigned requests review of the rejection from the Final Office Action (*Office Action*), having an electronic notification date of June 27, 2012, in the above-identified Application for at least the reasons discussed below. This request is being filed with a Notice of Appeal.

Advisory Action dated September 13, 2012

As a threshold issue, the Examiner failed to provide any guidance in the *Advisory Action* with reference to the prior response to the *Office Action*, the response having been filed August 22, 2012. Specifically, the *Advisory Action* stated that, "For purposes of appeal, the proposed amendment(s) . . . will be entered, and an explanation of how the new or amended claims would be rejected is provided below or appended."¹ However, the only statement on the *Advisory Action* was, "As per Applicant's arguments, see .. Final Office [*sic*] Action."² As required by the MPEP,

Once USPTO personnel have concluded the above analyses of the claimed invention under all the statutory provisions, including 35 U.S.C. 101, 112, 102 and 103, they should review all the proposed rejections and their bases to confirm that they are able to set forth a *prima facie* case of unpatentability. Only then should any rejection be imposed in an Office action. The Office action should clearly communicate the findings, conclusions and reasons which support them.³

The patent office has the initial burden of presenting a *prima facie* case of unpatentability. A *prima facie* case is adequately articulated by notifying the applicant of the reasons for its

¹ *Advisory Action* at 1.

² *Ibid.*

³ MPEP § 2106(VII); emphasis added.

rejections so long as the explanation is not “so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.”⁴ This requirement comes straight from Section 132 of the Patent Act.

Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, *together with such information and references as may be useful* in judging of the propriety of continuing the prosecution of his application.⁵

In the instant case, the Examiner failed to provide any guidance as to why the amendments made in response to the *Office Action* failed to overcome the cited art. The undersigned is perplexed how exactly the same rejections can apply to amended claims as will be shown below.

The Rejection of Claims Under 35 U.S.C. § 103(a)

On page 2, paragraph 5 of the *Office Action*, the Examiner rejected claims 1-8, 10-18, and 20 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,553,347 to Tavor *et al.* (*Tavor*) in view of U.S. Patent No. 6,556,974 to D’Alessandro. Since a *prima facie* case of obviousness has not been presented, the undersigned respectfully traverses the rejection.

The basis for an obviousness rejection is grounded in a consideration of all claim elements. “All words in a claim must be considered in judging the patentability of that claim against the prior art.”⁶ Additionally, to render the claimed subject matter obvious, the prior art references must teach or suggest every feature of the claims.⁷ The undersigned will show that the cited references, either singly or in combination, neither teach nor suggest all limitations of the claims of the Application.

In particular, amended claim 1 recites, *inter alia*,

A method of managing a dispute about a *pre-existing contract*, the method comprising:

⁴ *Chaster v. Miller*, 906 F.2d 1574 (Fed. Cir. 1990).

⁵ 35 U.S.C. § 132(a); emphasis added.

⁶ *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). See also MPEP § 2143.03.

⁷ See Manual of Patent Examining Procedure §§ 706.02(j), 2143(A) (2008); MPEP § 2142 (2006) (citing *In re Paack*, 947 F.2d, 488 (Fed. Cir. 1991)). Cited approvingly in *Ex parte WEN WEN* and PATRICIA NG at 7; Appeal No. 2009-000776; decided September 25, 2009.

automatically receiving, over a network by a system computer, information relating to the dispute, the information being generated from one of an initiator computer associated *with an initiator and a respondent computer associated with a respondent, the initiator and the respondent being parties to the pre-existing contract*; and

iteratively providing portions of the information to the other of the initiator computer and the respondent computer in accordance with predetermined criteria.

The other independent claim of the Application, claim 11, shares with claim 1 limitations similar to at least those shown above.

In contrast to all independent claims of the Application, *Tavor* is completely silent on dispute resolution relating to a dispute about a *preexisting contract*. Instead, *Tavor* merely discusses pre-contract types of price *negotiations*. Negotiations are steps that may be used in contract formation but they are not a contract. According to *Tavor*, a system and method are discussed in which the method is to conduct negotiations.

[F]or conducting ‘one to one’ commercial negotiations . . . The negotiation process consists of sending persuasive texts to the user by the system, including discounts given by the system and responses to the price offers of the user. The system offers the product for a specific price, a price that may be optionally decreased as negotiation continues.⁸

Since *Tavor* discusses only price negotiations prior to a contract ever being formed, *Tavor* fails to discuss, or even hint at, dispute resolution related to non-performance of a preexisting contract.

The Examiner relied exclusively on *D’Alessandro* only to teach or suggest “a method for evaluating current business performance.”⁹ Moreover, *D’Alessandro* merely discusses assessments of the performance of a business or other organization. “A system for providing accurate, quantifiable and reproducible assessments of an organization’s performance based on

⁸ *Tavor* at Abstract.

⁹ *Office Action* at 3.

predetermined criteria.”¹⁰ In fact, *D'Alessandro* fails to provide any discussion on any type of contract. Thus, *D'Alessandro* fails to remedy the deficiencies of *Tavor* discussed above.

Since the undersigned has shown that not all the claimed elements were known as required by relevant case law and the MPEP, either by *Tavor* singly or in combination with *D'Alessandro*, the undersigned submits that independent claims 1 and 11 are patentable. Further, since claims 2-8, 10, 12-18, and 20 depend from either claim 1 and 11, they too are allowable for at least the same reasons as the claim from which each depends. Further, these dependent claims each contain additional patentable subject matter. Therefore, the undersigned respectfully requests the Panel to reconsider and withdraw the rejection made by the Examiner under 35 U.S.C. §103 with regard to claims 1-8, 10-18, and 20.

Further, other than incentives related to potential price discounts, *Tavor* further fails to teach or suggest the additional claimed elements of dependent claims 4 and 14 reciting elements related to factors of the received information. *Tavor* does not discuss any type of factors related to an historical harm, a future harm, an incentive, a punishment, a request, an offer, and a desired outcome. Instead, in the passages of *Tavor* to which the Examiner specifically referred,¹¹ *Tavor* merely discusses comparing prices or offering discounts.

According to the present invention, there is provided a method for an automatic negotiation process with a user through an electronic interface for a product having a starting price and a price offer from the user, the steps of the method being performed by a data processor, the method comprising the steps of: (a) comparing the price offer to the starting price according to a negotiation comparator; (b) if the negotiation comparator is fulfilled by the price offer, accepting the price offer of the user; and (c) alternatively, if the negotiation comparator is not fulfilled by the price offer, offering a discount incentive to the user.¹²

Hereinafter, the term “discount incentive” refers to an incentive for a user to purchase a product, including but not limited to, a discount in the price of the product, a present (such as an additional product at a low cost or at no additional cost), a benefit

¹⁰ *D'Alessandro* at Abstract.

¹¹ See Office Action at 4.

¹² *Tavor* at col. 2, lines 31-41.

(such as a "buyers club" card) and a discount in the price of shipping the product.¹³

Consequently, *Tavor* is completely silent on point. The undersigned has searched the entirety of *Tavor* and can find no hint, or even a suggestion, of any type of factors related to an historical harm, a future harm, an incentive, a punishment, a request, an offer, and a desired outcome. Therefore, for at least these additional reasons, the undersigned requests the Panel to reconsider and withdraw the rejection made by the Examiner of claims 4 and 14 under 35 U.S.C. § 103(a).

Allowable Subject Matter

On page 2, paragraph 3 of the *Office Action*, the Examiner objected to claims 9 and 19 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The undersigned had previously thanked the Examiner for recognizing the novel and non-obvious nature of claims 9 and 19. However, as noted above, the undersigned has shown that claims 1-8, 10-18, and 20 are patentable. Therefore, the undersigned declines the opportunity to amend the claims to incorporate the limitations of claims 9 and 19 and the intervening claims.

CONCLUSION


The undersigned respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. Any member of the Panel is invited to telephone the undersigned attorney at (408) 660-2015 to facilitate prosecution of this application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date September 27, 2012

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¹³ *Id.* at col. 2, lines 56-61.